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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,405	04/09/2004	Miles Paschini	EWIR-001/02US 300933-2005	8429
23419 7590 01/14/2009 COOLEY GODWARD KRONISH LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW Washington, DC 20001			EXAMINER COPPOLA, JACOB C	
			ART UNIT 3621	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/821,405	<b>Applicant(s)</b> PASCHINI ET AL.	
	<b>Examiner</b> JACOB C. COPPOLA	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 10-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 31-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>15 February 2005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This action is in reply to Applicants' Response filed 09 December 2008 ("1st Restriction Response") to the Restriction and Election of Species mailed 10 November 2008.
2. Claims 1-35 are currently pending and have been examined.
3. All references to the capitalized versions of "Applicants" refer specifically to the Applicants of record. Any references to lower case versions of "applicant" or "applicants" refer to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally. The notations in this paragraph apply to this Office Action and any future office action(s) as well.
4. This Office Action is given Paper No. 20090110. This Paper No. is for reference purposes only.

### ***Restrictions***

5. Applicants' election of claims 1-9 and 31-35 in the 1st Restriction Response is acknowledged. Because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
6. Claims 10-30 are withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

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***Continuation in Part***

7. This application is a continuation-in-part (“CIP”) application of U.S. application no. 10/316,603 filed on 10 December 2002 (“Parent Application”). See MPEP §201.08. In accordance with MPEP §609.02 *A. 2* and MPEP §2001.06(b) (last paragraph), the Examiner has reviewed and considered the prior art cited in the Parent Application. Also in accordance with MPEP §2001.06(b) (last paragraph), all documents cited or considered ‘of record’ in the Parent Application is now considered cited or ‘of record’ in this application. Additionally, Applicants are reminded that a listing of the information cited or ‘of record’ in the Parent Application need not be resubmitted in this application unless Applicants desire the information to be printed on a patent issuing from this application. See MPEP §609.02 *A. 2*. Finally, Applicants are reminded that the prosecution history of the Parent Application is relevant in this application.

***Information Disclosure Statement***

8. The Information Disclosure Statement filed on 15 February 2005 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 4 and 32-34 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

11. Regarding claim 4:

a. This claim recites “in anticipation of going offline”. These claims are indefinite because the phrase “in anticipation of” renders the claim vague and indefinite.

12. Regarding claims 32-34:

b. These claims recite “said generating is initiated in response to a PIN inventory”. These claims are indefinite because there are two requests “generated” in claim 31 that this phrase can be referring to.

13. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. Claims 1-5, 7-9, and 31-35, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over White et al. (U.S. 6,169,975 B1) (“White”), in view of Bullen et al. (U.S. 7,197,662 B2) (“Bullen”).

16. Regarding claim 1:

c. White discloses the following limitations:

i. *a plurality of client terminals (terminal devices **110**), each of said plurality of client terminals being capable of requesting and receiving PINs (C6, L8-33; and C8, L39-52); and*

ii. *a plurality of servers operatively coupled to said plurality of client terminals (one or more host computer systems **601**), each of said servers including a corresponding one of a plurality of PIN inventories, wherein each of said servers is capable of sending PINs to at least one of said plurality of client terminals (C6, L8-33; and C8, L39 – C9, L48).*

d. White does not directly disclose the limitations:

iii. *a hub operatively coupled to each of said servers, wherein said hub is configured to send PINs to each of said plurality of servers for inclusion within said PIN inventories.*

e. Bullen, however, teaches the limitations:

iv. *a hub (hub **10**) operatively coupled to each of a plurality of servers (server **12-1** and server **12-2**), wherein said hub is configured to send PINs to each of said plurality of servers for inclusion within said PIN inventories.*

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f. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the system of White the hub as taught by Bullen since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

17. Regarding claim 2-5 and 7-9, White/Bullen discloses the limitations of claim 1, as described above. White/Bullen, further, discloses the following limitations:

g. Claim 2: *The system of claim 1 wherein said plurality of servers are geographically dispersed* (White, C7, L9-12);

h. Claim 3: *The system of claim 1 wherein each of said plurality of servers is configured to send PINs to said hub* (White, C6, L8-33; and C8, L39 – C9, L48);

i. Claim 4: *The system of claim 3 wherein at least one of said plurality of servers is configured to send PINs to said hub in anticipation of going offline* (White, C6, L8-33; and C8, L39 – C9, L48);

j. Claim 5: *The system of claim 1 wherein said hub is configured to request a quantity of PINs from at least one of said plurality of servers in response to another of said plurality of servers requesting at least said quantity of PINs* (Bullen, C5, L15-50);

k. Claim 7: *The system of claim 1 wherein said hub includes a central PIN inventory including a plurality of PIN varieties* (White, C6, L8-33; and C8, L39 – C9, L48; and Bullen, memory section **30**);

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- l. Claim 8: *The system of claim 7 wherein said hub is configured to distribute PINs in said central PIN inventory to at least one of said plurality of servers in advance of said hub going offline (Bullen, C5, L10+); and*
  - m. Claim 9: *The system of claim 1 wherein each of said plurality of servers tracks a quantity of at least one of a plurality of PIN varieties and requests additional quantities of said at least one of said plurality of PIN varieties in response to said quantity of said at least one of said plurality of PIN varieties falling below a low-watermark (White, C2, L61+).*
18. Regarding claim 31:
- n. White discloses the following limitations:
    - v. *receiving, at a server, a client request for a PIN, wherein said client request is generated at said client terminal and transmitted to said server (C6, L8-33; and C8, L39 – C9, L48); and*
    - vi. *sending said PIN to said client terminal in response to said client request (C6, L8-33; and C8, L39 – C9, L48).*
  - o. White does not directly disclose the limitations:
    - vii. *generating, at a server, a request for a PIN;*
    - viii. *transmitting said request for said PIN from the server to a hub; and*
    - ix. *receiving said PIN at said server from said hub.*
  - p. Bullen, however, teaches the limitations:
    - x. *generating, at a server, a request for data (C4, L4-18);*



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xi. *transmitting said request for said data from the server to a hub (C4, L4-18); and*

xii. *receiving said data at said server from said hub (C4, L4-18).*

q. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the method of White the hub and method as taught by Bullen since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

19. Regarding claims 32-35, White/Bullen discloses the limitations of claim 31, as shown above. White/Bullen, further, discloses the limitations:

r. Claim 32: *The method of claim 31 wherein said generating is initiated in response to a PIN inventory of said server not having said PIN (White, C2, L61+);*

s. Claim 33: *The method of claim 32 wherein said generating is in advance of the receiving of said client request at said server (White, C2, L61+);*

t. Claim 34: *The method of claim 33 including: receiving, at said server, a hub request for another PIN, wherein said hub request is generated at said hub and transmitted to said server; and sending said other PIN to said hub (White, C2, L61+);*  
and

u. Claim 35: *The method of claim 31 including: sending, in advance of going offline, PINs in a PIN inventory at said server to said hub (White, C2, L61+).*

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20. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over White/Bullen, in further view of Official Notice.

21. Regarding claim 6:

v. White/Bullen discloses the limitations of claim 1, as described above.

White/Bullen does not directly disclose the following limitations:

xiii. *wherein said hub includes a central dealer database and each of said plurality of servers includes a corresponding one of a plurality of dealer databases, and wherein said hub is configured to synchronize said central dealer database with said plurality of dealer databases so that each of said plurality of dealer databases includes substantially current dealer information.*

w. However, the Examiner takes Official Notice that a hierarchical server system employing synchronization to files common among a domain of servers is old and well-known in the art because it maintains assurance to the users of the domain that data is consistent.

x. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to apply this old and well-known practice to the system of White/Bullen in order to maintain data consistency.

22. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the

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claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

23. In light of Applicants' choice to pursue product claims, Applicants are reminded that functional recitations using the word and/or phrases "for", "adapted to", "configured to", or other functional language (*e.g.* claim 1 recites "said hub is configured to send PINs") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 31.06 II (C.), 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in the paragraph apply to all claims currently pending.

24. Since the application currently before the Examiner is a utility patent, the claims must be directed to systems, methods, or articles of manufacture that have a clear utility. See MPEP 706.03(a). Over the years, numerous court decisions have analyzed the content of various claim language for meaningful, useful differences in structure or acts performed between the claims and the prior art. Some of these decisions have found that certain language adds little, if anything, to the claimed structure or acts and therefore do not serve as a limitation on the claims

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to distinguish over the prior art. Thus, the limitations on the claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *In re Gulack*, 217 USPQ 401 (CAFC 1983), *Ex parte Carver*, 227 USPQ 465 (bdPatApp&Int 1985) and *In re Lowry*, 32 USPQ2d 1031 (CAFC 1994), where language provided certain limitations because of specific relationships required by the claims. In the computer arts we frequently examine claims that are directed to systems, methods, and articles (computer program products) that process data. In these specific cases, nonfunctional descriptive material is material that cannot exhibit any functional interrelationship with the way in which computing processes are performed.

25. As a result, when analyzing claim language for its limited effect, the Examiner will perform two basic steps:

- y. Review the claimed as a whole to see whether or not any descriptive material is being recited; and
- z. If a descriptive material is found, determine how this descriptive material is being used in the claim as a whole.

26. In this case, the claim language contains nonfunctional data in the form of “PINs”. This nonfunctional data is not processed by the computer, nor does it alter the process steps. It only means something to the human mind.

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27. Using the broadest reasonable interpretation, the following definitions are relied upon by the Examiner when interpreting claim language:

- aa. **offline** “2. In reference to one or more computers, being disconnected from a network” (Computer Dictionary, 5<sup>th</sup> Edition, Microsoft Press, Redmond, WA, 2002).

### ***Double Patenting***

28. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

29. A timely filed terminal disclaimer in compliance with 37 C.F.R. §§ 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly

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owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

30. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. §3.73(b).

31. Claims 1-9 and 31-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/821,815. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims share common elements differing only in terminology.

32. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

33. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see e.g. “User Level Beginning...”), because of the references’ basic content (which is self-evident upon examination of the references), and after further review of

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the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within these references.

34. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure (see attached form PTO-892).

35. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

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Patent Examiner, Art Unit 3621  
January 11, 2009

/ANDREW J. FISCHER/  
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